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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/248,524    02/09/99    SHAH

A    2870/72

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HM12/0315

EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

03/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/248,524

Applicant(s)

SHAH, AMIT R.

Examiner

Alysia Berman

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Receipt is acknowledged of the information disclosure statement filed 9 February 1999.

Claims 1-22 are pending.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claims 1, 10 and 19 recite Markush groups but are not written in proper Markush form. The proper language for a Markush group is, for example, "selected from the group consisting of A, B **and** C" or "wherein ... is A, B **or** C." Correction is requested.
6. Claim 16 does not contain a period at the end. Correction is required.
7. Claims 16, 18 and 22 are indefinite because they recite the limitation "nib-type." The addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. *Ex parte* Copenhaver, 109 USPQ 118 (Bd. App. 1955). It is unclear how the materials have to resemble a nib to satisfy the limitations of the claim. See *Ex parte* Caldwell, 1906 C.D. 58 (Comm'r Pat. 1906).
8. Claims 5 and 14 recite the limitation "ammonium acrylate." There is insufficient antecedent basis for this limitation in the claim. Both claims depend from claims that recite alkylacrylates.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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10. Claims 1-4, 6, 7, 9-13 and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4423031 ('031).

The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment.

US patent '031 discloses a liquid eyeliner comprising a copolymer of a C<sub>4</sub>-C<sub>18</sub> alkyl acrylate and a C<sub>1</sub>-C<sub>4</sub> alkyl methacrylate (abstract, claims, and examples). The composition further comprises an organic pigment in an amount of 10% and 5-60% of the polymer (Table 2). The eyeliner may be in the form of a flow-through applicator such as a pen (nib-type applicator) (col. 6, lines 27-29). Body paint is disclosed at column 6, line 40. See example 3 for the process of mixing the polymer with the pigment. The composition is water-resistant and rub-proof (long wearing) (col. 6, lines 27-29).

11. Claims 1-4, 6-13, 15, 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4712571 ('571).

The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment.

US Patent '571 discloses a nail polish (body paint) composition comprising a methyl-butyl methacrylate copolymer (claim 6) and an organic pigment such as FD&C yellow 5 (col. 2, lines 32-35). Acrylic and methacrylic polymers are also disclosed at column 9, lines 19-25 as suitable film-formers. See claim 7 for the polymer in an amount from about 2.0-25.0 weight percent. The pigment comprises from 0.6-12.0% of the nail polish (col. 12, lines 17-18). Claim 25 and the abstract disclose a pen-type applicator with a non-bristle nib (nib-type applicator).

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The nail polish is prepared by mixing the pigment paste or slurry with the other ingredients (col. 12, lines 14-16), that includes the polymer. The claims are drawn to a cosmetic composition and, therefore, the expression “long-wearing” is inherent.

12. Claims 1-7, 9-14 and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5874072 ('072).

The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment.

US Patent '072 discloses a mascara comprising ammonium acrylate (examples) and organic pigments (col. 6, lines 1-9). The examples teach from 10-34% polymer in the composition. The amount of pigment is from about 3-30% (col. 6, lines 4-7). For the process of mixing the polymer with the pigments, see the processing directions at column 7. The mascara composition exhibits improved wear (long wearing). The expression “comprising” in the claims is inclusive of all the additional ingredients in major amounts. See *Ex parte* Davis, 80 USPQ 448, 450 (Bd. App.1948).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 1-7 and 9-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '031 in view of US '072.

The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment.

US '031 discloses an eye makeup composition comprising a polymer and an organic pigment as stated in the 35 USC 102(b) rejection above. US '031 does not disclose ammonium acrylate as in claims 5, 14 and 22 of the instant application.

US '072 discloses an eye makeup composition comprising ammonium acrylate and organic pigments as stated in the 35 U.S.C. 102(e) rejection above. US '072 does not disclose a flow-through applicator or a nib-type eyeliner pen as in claims 15-18 of the instant application. However, it well known that mascara is applied using a brush applicator dipped in liquid, which is considered equivalent to a flow-through applicator.

The prior art discloses eye makeup compositions that comprise ammonium acrylate and organic pigments that are applied with a nib applicator. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the ammonium acrylate taught by US '072 in the composition of US '031 with the reasonable expectation of providing an improved eye makeup composition that is applied with a nib-type applicator, such as a pen. The motivation lies in the desire for an eye makeup composition with improved wear that can be easily applied and removed with soap and water.

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '031 and US '072 as applied to claims 1-7 and 19-22 above, and further in view of US '571.

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The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment which is FD&C yellow no. 5.

Patent '031 teaches generically pigments (col. 4, line 2 and the tables at columns 9 and 10). Patent '072 teaches D&C pigments (col. 6, lines 21-32). Patent '571 discloses specific pigment at column 2, lines 28-39. The '571 patent teaches equivalency between D&C and FD&C pigments. One of ordinary skill in the art would prepare the composition of Patent '031 and use ammonium acrylate of Patent '072 and substitute FD&C pigments of Patent '571 into the composition in view of the equivalency between FD&C and D&C pigments. Therefore, there is a *prima facie* case of obviousness.

16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '031 and US '072 as applied to claims 1-7 and 9-22 above, and further in view of US 4761277 ('277).

The instant invention is drawn to a cosmetic composition comprising an acrylic, acrylate, methacrylic or methacrylate polymer or copolymer and an organic pigment which is FD&C yellow no. 5 and blue no. 1.

Patent '031 teaches generically pigments (col. 4, line 2 and the tables at columns 9 and 10). Patent '072 teaches D&C pigments (col. 6, lines 21-32). Patent '277 discloses specific pigments at column 1, lines 58-62. The '277 patent teaches equivalency between D&C and FD&C pigments. One of ordinary skill in the art would prepare the composition of Patent '031 and use ammonium acrylate of Patent '072 and substitute FD&C pigments of Patent '277 into



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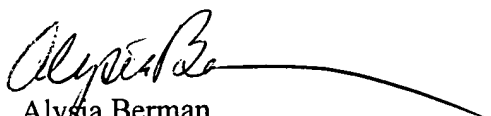
the composition in view of the equivalency between FD&C and D&C pigments. Therefore, there is a *prima facie* case of obviousness.

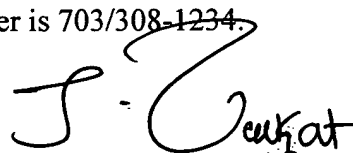
### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703/308-4638. The examiner can normally be reached on 8:00-4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703/308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3704 for regular communications and 703/305-3704 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.

  
Alysia Berman  
Patent Examiner  
March 8, 2000

  
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PRIMARY EXAMINER  
GROUP 4500 / 600